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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,953	08/02/2001	Masao Akimoto	P20745	4285
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GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			JEAN, FRANTZ B	
			ART UNIT	PAPER NUMBER
			2151	

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/919,953

Applicant(s)

AKIMOTO ET AL.

Examiner

Frantz B. Jean

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/05/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to the amendment filed on 1/05/06. Claims 1-13 were canceled. New claims 14-32 have been added. Therefore, claims 14-32 are pending in this application.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 01/05/06 was filed after the mailing date of the non-final office action mailed on 10/05/05. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

The double patenting rejection submitted in the previous office action has been withdrawn because the claims of both applications have been amended.

Claim Objections

Claims 14, 16, 18 –20, 23-27, and 29-32 are objected to because of the following informalities: they contain multiple acronyms such as: HTTP, SMTP, HTML, HELO, POP3, and TIFF that need to be defined in the claims. Appropriate correction is required.

Furthermore, Applicant is requested to replace “an” by –a— before HTTP and SMTP in the claims.

Claim Rejections - 35 USC § 112

Claim 32 recites the limitations "controlling communication with the Internet facsimile apparatus in accordance with the POP3 protocol when the predetermined signal type". Internet facsimile apparatus, POP3 protocol and predetermined signal type were not cited in the claim before.

Furthermore, extracting the image data from the HTML data was not cited in the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 30 recites "controlling communication with the Internet facsimile apparatus in accordance with the SMTP protocol when the predetermined signal-type is detected".

The Internet facsimile apparatus, the SMTP protocol and the predetermined signal-type were not cited in the claim.

Furthermore, transmitting the HTML data was not cited in the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 14-18, 22, 23, 25-26, and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al. (hereinafter, "Okada") US patent Number 6,876,462) in view of Tada US patent Number 6,237,040.

As per claim 14, Okada teaches a communication control apparatus, comprising:
a first interface connected to a network (fig 4, 34) that is controlled by a server in accordance with a protocol;
a second interface connected to an Internet facsimile apparatus (fig 4, 29, 35) that transmits e-mail data in accordance with an SMTP protocol; a processor (fig 4, 22) that controls communication with the Internet facsimile apparatus in accordance with the protocol; a processor (fig 4, 31) that controls communication with the server in accordance with the protocol; an e-mail communicator that receives the e-mail data from the Internet facsimile apparatus under the control of the processor (The netfax receives 14 receives email of facsimile from the requesting node 12, col. 8 lines 58-62); a processor that produces command data for the server based upon the e-mail data received from the Internet facsimile apparatus and a communicator that transmits the command data produced by the processor and the e-mail data received from the Internet facsimile apparatus to the server under the control of the processor (CPU 1 instructs facsimile section 6 to transmit a request, facsimile section 6 performs the request col. 6 lines 48-55). However; although HTTP is implicit in network communication and SMTP is implicit in email communication, Okada does not explicitly elaborate on them. HTTP and SMTP are well known in the art of computer network as evidenced by Tada (see col. 1 line 7 to col. 2 line 29). Therefore, it would have been apparent to one of ordinary skill in the art at the time of the invention to incorporate Tada's HTTP, SMTP, POP3, and HTML into Okada's for transfer of information (see Tada col. 1 lines 15-27).

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As per claim 15, Okada-Tada teaches a communication control apparatus according to claim 14, the server being configured to manage a network by a groupware software and the communication control apparatus being connected with the server via the network (see Okada element 13, fig 3).

As per claim 16, Okada-Tada teaches a communication control apparatus according to claim 15, wherein the command data comprises information regarding a destination of the e-mail and is in HTML format (see Okada col. 9 lines 25-37; HTML format has already been discussed above).

As per claim 17, Okada-Tada teaches a communication control apparatus according to claim 16, wherein the e-mail data is stored in a mailbox of the server, when the destination for the e-mail data is a terminal managed by the server, and, when the destination is a terminal not managed by the server, the e-mail data is transferred to a mail server connected with the server via the Internet (see Okada col. 9 lines 29-49).

As per claim 18, Okada-Tada teaches a communication control apparatus according to claim 17, further comprising: a signal-type detector that detects a type of a signal transmitted via the first interface, wherein, when said signal-type detector detects reception of a predetermined signal type from the Internet facsimile apparatus, said HTTP processor starts controlling communications with the server in accordance with the HTTP protocol and said SMTP processor controls communication with the Internet facsimile apparatus in accordance with the SMTP protocol (a signal-type detector is implicit in Okada, see col. 3 lines 20-29; col. 4 lines 38-44).

As per claim 22, Okada-Tada teaches a communication control apparatus according to claim 14, said processor being configured to produce the command data by extracting addressee, subject, and file name data from the e-mail data received from the Internet facsimile apparatus (see Okada col. 4 lines 38-51 and col. 10 lines 10-28).

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okada-Tada in view of Guedalia et al. US publication number 2010042136.

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As per claim 19, Okada-Tada teaches a communication control apparatus according to claim 18, wherein said HTTP processor starts controlling a communication with the server in accordance with the HTTP protocol (as discussed above). However, Okada-Tada fails to explicitly discuss a HELO signal, which is a command signal in accordance with the SMTP protocol. Guedalia is directed to an on-the-fly message notification system and methodology that comprises a HELO signal (The SMTP commands preferably comprise HELO, FROM, RCPT, DATA and QUIT commands; In a typical SMTP session, where a sender and a recipient, typically embodied in a client and a server, are engaged in conversation, the recipient receives a HELO command from the sender to initiate communication; see paragraph 0040-0041). It would have been obvious to one skill artisan at the time of the invention to incorporate the HELO signal into Okada-Tada's system to initiate conversation between a sender and a recipient (Guedalia, par 0041).

Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada-Tada-Guedalia as applied to claim 19 above, and further in view of Barlow et al. (hereinafter, "Barlow") US patent Number 6,038,551.

As per claims 20-21, the combination Okada-Tada-Guedalia fails to disclose an encryption processor that encrypts data; IC card and insertable slot. Barlow discloses a multipurpose, integrated circuit card and complimentary computer software. Barlow discloses all features regarding encryption processor that encrypts data, IC card, card reader, which implicitly includes an insertable slot (see Barlow's figs 2-3, abstract and col. 4 line 60 to col. 5 line 1-19 and 49-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Barlow's encryption processor to the combination's system because it would protect the combination data and system against malicious attacks from other software applications by offering secure storage and transportation of private keys for use in different application contexts, without jeopardizing or exposing private keys (Barlow col. 4 lines 50-57).

As per claim 23, Okada teaches a communication control apparatus comprising:

- a first interface (fig 4, 34) connected to a network that is controlled by a server in accordance with a protocol;
- a second interface (fig 4, 29, 35) connected to an Internet facsimile apparatus that receives e-mail data in accordance with a protocol;
- a processor (fig 4, 22) that controls communication with the Internet facsimile apparatus in accordance with the

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protocol; a processor (fig 4, 31) that controls communication with the server in accordance with a protocol; a communicator that receives data including image data from the server under the control of said processor (The netfax receives 14 receives email of facsimile from the requesting node 12, col. 8 lines 58-62); an HTML processor that extracts the image data from the data received from the server (see col. 4 lines 38-51 and col. 10 lines 10-28); and an e-mail communicator that transmits the image data to the Internet facsimile apparatus under the control of said processor (The netfax receives 14 receives email of facsimile from the requesting node 12, col. 8 lines 58-62). However, although HTTP and is implicit in network communication and SMTP is implicit in email communication, Okada does not explicitly elaborate on them and some other protocol. HTTP, POP3, HTML and SMTP are well known in the art of computer network as evidenced by Tada (see col. 1 line 7 to col. 2 line 29). Therefore, it would have been apparent to one of ordinary skill in the art at the time of the invention to incorporate Tada's HTTP, SMTP, POP3, and HTML into Okada's for transfer of information (see Tada col. 1 lines 15-27).

As per claim 25, Okada-Tada combination teaches a communication control apparatus according to claim 23, further comprising: a signal-type detector that detects a type of signal transmitted by said first interface; wherein said HTTP processor starts communication with the server in accordance with the HTTP protocol and said POP3 processor controls communication with the Internet facsimile apparatus in accordance with the POP3 protocol when said signal-type detector detects transmission of a predetermined type of signal from the Internet facsimile apparatus (a signal-type detector is implicit in Okada, see col. 3 lines 20-29; col. 4 lines 38-44).

As per claim 26, Okada-Tada combination teaches a command signal in accordance with the POP3 protocol, from the Internet facsimile apparatus (CPU 1 instructs s facsimile section 6 to transmit a request, facsimile section 6 performs the request col6 lines 48-55 of Okada).

As per claim 30, Okada teaches a communication control method comprising: controlling communication (fig 1, element 9) with a server in accordance with a protocol via a first interface (fig 4, 34) connected to a network managed by a server in accordance with a protocol; controlling a communication (element 9) with the

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Internet facsimile apparatus in accordance with the protocol when the predetermined signal-type is detected (a signal-type detector is implicit in Okada, see col. 3 lines 20-29; col. 4 lines 38-44); detecting a predetermined type of signal (a signal-type detector is implicit in Okada, see col. 3 lines 20-29; col. 4 lines 38-44) in accordance with a protocol from a second interface (fig 4, 35,29) connected to an Internet facsimile apparatus; receiving e-mail data from the Internet facsimile apparatus in accordance with the protocol (The netfax receives 14 receives email of facsimile from the requesting node 12, col. 8 lines 58-62); producing command data for the server based on the e-mail data received from the Internet (CPU 1 instructs facsimile section 6 to transmit a request, facsimile section 6 performs the request col. 6 lines 48-55); and transmitting the HTML data to the server in accordance with the HTTP protocol (col. 9 lines 29-37; col. 10 lines 13-27). However, although HTTP is implicit in network communication and SMTP is implicit in email communication, Okada does not explicitly elaborate on them. HTTP and SMTP are well known in the art of computer network as evidenced by Tada (see col. 1 line 7 to col. 2 line 29). Therefore, it would have been apparent to one of ordinary skill in the art at the time of the invention to incorporate Tada's HTTP, SMTP, POP3, and HTML into Okada's for transfer of information (see Tada col. 1 lines 15-27).

As per claim 31, Okada-Tada teaches a communication control method according to claim 30, wherein producing command data comprises extracting addressee, subject, and file name data from the e-mail data received from the Internet (see Okada col. 4 lines 38-51 and col. 10 lines 10-28).

As per claim 32, a communication control method comprising: controlling communication (fig 1, element 9) with a server in accordance with a protocol via a first interface (fig 4, 34) connected to a network managed by the server in accordance with a protocol; controlling communication (element 9) with the Internet facsimile apparatus in accordance with a protocol when the predetermined signal type is detected (a signal-type detector is implicit in Okada, see col. 3 lines 20-29; col. 4 lines 38-44); detecting a predetermined signal-type (a signal-type detector is implicit in Okada, see col. 3 lines 20-29; col. 4 lines 38-44) in accordance with a POP3 protocol from a second interface (fig 4, 35,29) connected to an Internet facsimile apparatus; receiving data including image data from the server in accordance with the

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protocol (col. 9 lines 5-12); extracting the image data from the data and transmitting the extracted image data to the Internet facsimile apparatus in accordance with the protocol (see col. 4 lines 38-51 and col. 10 lines 10-28). However, although HTTP is implicit in network communication and SMTP is implicit in email communication, Okada does not explicitly elaborate on them. HTTP and SMTP are well known in the art of computer network as evidenced by Tada (see col. 1 line 7 to col. 2 line 29). Therefore, it would have been apparent to one of ordinary skill in the art at the time of the invention to incorporate Tada's HTTP, SMTP, POP3, and HTML into Okada's for transfer of information (see Tada col. 1 lines 15-27).

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okada-Tada in view of Iida Us patent number 6,900,903.

As per claim 24, Okada and Tada fail to teach a communication control apparatus according to claim 23, wherein the image data is a TIFF file. This feature is well known in the art of email and fax as evidenced by Iida (fig 3, element 14; col. 4 lines 20-21 and 38-58). It would have been apparent to one of ordinary skill in the art at the time of the invention to incorporate a TIFF into Okada-Tada's feature in order to enable the network facsimile to communicate information including image data throughout the system (Iida col. 2 lines 35-44).

Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada-Tada as applied to claim 23 above, and further in view of Barlow et al.

(hereinafter, "Barlow") US patent Number 6,038,551.

As per claims 27-29, the combination Okada-Tada fails to disclose a decryption processor that decrypts data; IC card and insertable slot. Barlow discloses a multipurpose, integrated circuit card and complimentary computer software. Barlow discloses all features regarding decryption processor that decrypts data; IC card, card reader, which implicitly includes an insertable slot (see Barlow's figs 2, 11-12, abstract and col. 4 line 60 to col. 5 line 1-19 and 49-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Barlow's decryption processor to the combination's system because it would protect the combination data and system against malicious attacks from other software applications by offering

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secure storage and transportation of private keys for use in different application contexts, without jeopardizing or exposing private keys (Barlow col. 4 lines 50-57).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz B. Jean whose telephone number is 571-272-3937. The examiner can normally be reached on 8:30-6:00 M-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571 272 3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frantz Jean



FRANTZ B. JEAN
PRIMARY EXAMINER